

REMARKS

Claims 1, 5, 6, 9, 10, and 17-32 are pending in the current application. Claims 1 and 17-20 are independent. Claims 1, 5, 6, 9, 10, 17-20 are amended. Claims 21-32 are newly added.

Claim Rejections – 35 U.S.C. § 101

Claims 1, 5-6 and 9-10 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the Examiner's comments regarding computer readable mediums on page 2 of the January 11, 2008 Office Action, claim 1 has been amended and now recites "a *computer-readable* medium having a data structure" (emphasis added). Applicants respectfully submit claim 1, as amended, is directed to statutory subject matter and satisfies the requirements of §101.

Additionally, Claims 5-6 and 9-10 were rejected specifically for depending from claim 1. In view of the amendments to claim 1, Applicants respectfully submit claims 5-6 and 9-10 are directed to statutory subject matter and satisfy the requirements of §101.

Therefore, Applicants respectfully request this rejection of claims 1, 5-6 and 9-10 under §35 U.S.C. §101 be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 5-6, 9-10, 15 and 17-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US 6,266,483, ("Okada") in view of US 2003/0014760 ("Yamauchi").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit, neither Okada nor Yamauchi teach each of the limitations in amended claim 1 as is required to establish a *prima facie* case of obviousness. Claim 1 has been amended and now recites “wherein the information file further includes mapping information, the mapping information mapping address information to a presentation time for the at least one still image.” This amendment is supported by at least paragraph [0025] and [0026] of Applicants’ specification. Neither Okada nor Yamauchi teach this limitation as is required to support a *prima facie* case of obviousness

Further, the Examiner has no motivation for one of ordinary skill in the art to combine the Yamauchi and Okada references as the Examiner suggests. The Examiner asserts one of ordinary skill in the art would be motivated to add the length indicator of Yamauchi to the data structure of Okada “because it would make managing the file more effective” (*January 11, 2008 Office Action*: pg. 5). However, the Examiner has identified no information in either Yamauchi or Okada which would suggest to one of ordinary skill in the art that adding a length indicator to the data structure already taught by Okada would result in more effective data management. Accordingly, the Examiner has not provided motivation for one of ordinary skill in the art to make the suggested modification as is required to support a *prima facie* case of obviousness.

For at least the reasons stated above, the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 1 as is required to support a rejection under §103.

Additionally, independent claims 17-20 have been amended and contain limitations similar to those in claim 1. Accordingly, at least by virtue of their similarity to claim 1, the Examiner cannot establish a *prima facie* case of obviousness with respect to any of claims 17-20 as is required to support a rejection under §103.

Further, claims 5, 6, 9, and 10 depend from claim 1. Accordingly, at least by virtue of their dependence from claim 1, the Examiner cannot establish a *prima facie* case of obviousness with respect to any of claims 5, 6, 9 and 10 as is required to support a rejection under §103.

Therefore, Applicants respectfully request this rejection of claims 1, 5-6, 9-10, and 17-20 under 35 U.S.C. §103 be withdrawn.

New Claims

Claims 21-32 are newly added. Claims 21-23 depend from claim 17, claims 24-26 depend from claim 18, claims 27-29 depend from claim 19, and claims 30-32 depend from claim 20. For the reasons stated above, Applicants believe claims 17-20 to be allowable over the present art. Accordingly, at least by virtue of their dependence from claims 17-20, Applicants believe claims 21-32 to be allowable over the present art.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the pending claims of this application is earnestly solicited.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the Office Action and submit the required \$120.00 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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